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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/153,230	09/15/98	TOGNAZZINI B	50253-148(P1

LM02/1223

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EXAMINER	
WU, X	
ART UNIT	**PAPER NUMBER**
2774	10

DATE MAILED: 12/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/153,230	Tognazzini
Examiner	**Group Art Unit**
XIAO Yu	2774

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 9-30-99.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-2, 4-17, 22-42 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-2, 4-17, 22-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 37, 40-41 are rejected under the judicially created doctrine of double patenting over claims 1-3 of U. S. Patent No. 5,859629 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: selection of touch keys modifies a granularity of movement controlled by the strip of touch sensitive material.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-5, 7-11, 35-36, 38-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamoto (U.S. Patent No. 5,365,254).

As to claims 1, 7, 35-36, 38-39, Kawamoto discloses an input device for providing user controlled inputs, comprising: a strip of touch sensitive material (13) sensitive to a range of pressure (e.g. zero pressure or pressure), strip having a substantially constant width and a length which is at least twice the width (see Fig. 3, item 13); and interface (21, Fig. 4) connecting strip to a computer and responsive to human contact with the strip in order to transpose the position and pressure value of the contact into a data signal and to output the data signal (see 2, lines 51-67).

As to claims 2, 8, Kawamoto discloses that the interface does not transpose the widthwise of the contact and the data signal does not indicate the widthwise position of the contact (e.g. the touch zones positioned along the length).

As to claims 4, 10, Kawamoto discloses that the substantially contact width is approximately the width of a human finger (column 2, lines 56-57).

As to claims 5 and 11, Kawamoto discloses that the linear touch input device further comprises a number of touch keys or buttons (14, 16, 17).

As to claim 9, Kawamoto discloses the contact involving the pressure.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 6, 12-17, 22-26, 28-33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamoto (U.S. Patent No. 5,365,254) in view of Bequaert (U.S. Patent No. 4,042,777).

As to claims 6, 12-17 and 42, it is noted that Kawamoto does not discloses the number of keys or buttons is four and wherein said keys or buttons are located on said linear touch input device in a position so as to be operable by the fingers of a hand while said strip of touch sensitive material is simultaneously touched by the thumb of the hand. Bequaert discloses a touch input device comprises four keys (finger section) and a strip (thumb section) both can be touched simultaneously. It would have been obvious to one of ordinary skill in the art to have modified the input device of Kawamoto with the features of keys arrangements and simultaneously touched as taught by Bequaert, because the simultaneously touched and the finger input keys can more character inputs by using less keys.

As to claims 22-23, 25-26, 29-30, 32, it is noted that Kawamoto does not discloses a keyboard having a plurality of alphanumeric keys and linear touch input device being integrated with the keyboard. Bequaert is cited to teach the touch input device can be integrated with keyboard for inputting characters. It would have been obvious to have integrated a keyboard of

Bequaert into the touch input device of Kawamoto because Bequaert's Keyboard can provide additional functions such as inputting alphanumeric data to the screen so that the user can do both cursor control and inputting characters.

As to claims 24, 31, Kawamoto discloses that the processor controls scrolling of the display in accordance with the input data signal (e.g. cursor scrolling).

As to claim 28, it is well known in the art that any computer system can be connected to network. It would have been obvious to one of ordinary skill in the art to have connected the computer system of Kawamoto to the network, so that the user can interactive with other users.

As to claim 33, Kawamoto discloses the input device is a pointing device (e.g. controlling cursor movement).

7. Claims 27 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamoto (U.S. Patent No. 5,365,254) in view of Bequaert (U.S. Patent No. 4,042,777) as applied to claims 22-26 and 29-33 above, and further in view of Smith et al (U.S. Patent No. 5,111,005).

It is noted that both Kawamoto do not discloses the pointing device comprises a two-dimensional pointing device and computer program includes a routine for processing the signal from two-dimensional pointing device with the input data signal to generate a three-dimensional input signal. Smith is teach a touch pointing device which can generating either two-dimensional input signal or three-dimensional input signal. It would have been obvious to one of ordinary skill in the art to have modified Kawamoto as modified with the features of multi-dimensional input

control as taught by Smith, so that the user can use the pointing device in a three-dimensional display.

8. Applicant's arguments filed 9-30-1999 have been fully considered but they are not persuasive.

Applicant argues that the double patenting rejection is improper because the claims in the patent are to a method, while the rejected claims in this application are to an apparatus. This argument is not persuasive because the patent and the application are claiming common subject matter such as selection of touch keys movement controlled by the strip of touch sensitive material. Applicant argues that Kawamoto does not teach "position and pressure... into a data signal" as recited in claim 1. This argument is not persuasive because Kawamoto clearly teach that the touch area can detect the pressure applied by the user and the touch position of the touch area. With regarding to the 103 rejection, applicant argues that the combination of Kawamoto and Bequaert is not proper because Bequaert is direct to a keyboard and Kawamoto is directed to a display device that will not function if the touch area is moved to keyboard. This argument is not persuasive because the cursor control device is not necessary located adjacent to display and it can be located on the keyboard just like the conventional keyboard including both functions of inputting characters and controlling cursor.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The US patent 5,841,423 is cited to teach a touch strip located on a keyboard.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xiao Wu whose telephone number is (703) 305-4721. The examiner can normally be reached on Monday to Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this final action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

xw

December 20, 1999

XIAO WU
PRIMARY EXAMINER
ART UNIT 2774